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20995	7590	12/06/2005	VAN BRAMER, JOHN W

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ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/896,274	FERNANDEZ, SERGIO
	Examiner	Art Unit	
	John Van Bramer	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 June 2001</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-55</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-55</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>19 October 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06072002</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

.1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1-21,23-27,29-45, 47,48, and 50-55 are rejected under 35 U.S.C. 102(b)

as being anticipated by <u>DeLorme et al</u> (WO 98/35311).

Claim 1:   <u>DeLorme</u> discloses a method of producing customized information

documents, the method comprising:

a.   Recording a plurality of user preferences; retrieving service

provider information that is associated with a service host, a location, or a

subject (Page 45, line 21 through Page 46, line 23)

b.   Identifying a portion of the information that relates to the user

preferences. (Page 45, line 21 through Page 46, line 23)

c.   Creating a custom information document using the identified portion

of the service provider information. (Page 45, line 21 through Page 46, line

23)

d.   Outputting the custom information document. (Page 45, line 21

through Page 46, line 23)

Claim 2:   DeLorme discloses the method of claim 1, wherein the user preferences are determined from the results of a questionnaire that includes a plurality of questions. (Page 45, line 21 through Page 46, line 23)

Claim 3:   DeLorme discloses the method of claim 2, wherein the questions are classified by subject. (Page 45, line 21 through Page 46, line 23)

Claim 4:   DeLorme discloses the method of claim 1, wherein information about the geographical location of service providers and service hosts is retrieved and used to determine location relevance. (Page 45, line 21 through Page 46, line 23)

Claim 5:   DeLorme discloses the method of claim 4, wherein the service provider information includes a geographic location of a service provider, and wherein the geographic location is used to generate a mark on a map indicating the position of the service provider. (Page 26, line 26 through Page 27, line 32)

Claim 6:   DeLorme discloses the method of claim 1, wherein the service provider information that is to be retrieved from one or more sets of information is specified by a service provider. (Page 21, line 23 through Page 22, line 20)

Claim 7:   DeLorme discloses the method of claim 6, wherein the service provider specifies the information set that is to be retrieved based on a time constraint. (Page 21, line 23 through Page 22, line 20 and Page 34, lines 5-28)

Claim 8:   DeLorme discloses the method of claim 6, wherein the service provider specifies the information set that is to be retrieved based on the number of custom information documents that have been created and that include the service

provider information. (Page 21, line 23 through Page 22, line 20 and Page 34, lines 5-28)

Claim 9:   DeLorme discloses the method of claim 6, wherein the service provider interactively edits or selects the service provider information that is to be retrieved concurrently with the creating of the custom information document. (Page 21, line 23 through Page 22, line 20 and Page 34, lines 5-28)

Claim 10:   DeLorme discloses the method of claim 1, wherein a template is used to generate the layout of the custom information document. (Page 21, line 23 through Page 22, line 20)

Claim 11:   DeLorme discloses the method of claim 1, wherein recording user preferences includes formatting a questionnaire-based user interface comprising questions and answers. (Page 45, line 21 through Page 46, line 23)

Claim 12:   DeLorme discloses the method of claim 11, wherein the questionnaire-based user interface comprises a program that formats and prints questionnaires, wherein a user answers the questionnaires with a pen or pencil, and wherein the questionnaires are scanned and processed by the program to determine user preferences. (Page 24, lines 5-18 and Page 45, line 21 through Page 46, line 23)

Claim 13:   DeLorme discloses the method of claim 12, wherein handwritten information on the questionnaire is stored by the program. (Page 24, lines 5-18)

Claim 14:   DeLorme discloses the method of claim 11, wherein different questionnaires are printed according to different user profiles. (Page 56, lines 1-14)

Claim 15:   DeLorme discloses the method of claim 11, wherein the

questionnaire is formatted to produce an Hypertext Markup Language interface and the

user answers the questionnaire using a web browser to record user preferences. (Page

23, line 8 through Page 24, line 4)

Claim 16:   DeLorme discloses the method of claim 11, wherein the

questionnaire is formatted by a program to produce an Hypertext Markup Language

interface suitable for television display and the user answers the questionnaire using the

remote control of the television to record user preferences. (Page 23, line 8 through

Page 24, line 4)

Claim 17:   DeLorme discloses the method of claim 11, wherein the

questionnaire is formatted by a program to produce a file that is then used by an audio-

text system to prompt the user with voice messages and the questionnaire is answered

through the telephone. (Page 23, line 8 through Page 24, line 4 and Page 38, line 12

through Page 39, line 4)

Claim 18:   DeLorme discloses the method of claim 11, wherein the

questionnaire is formatted to produce a file that is downloaded to a personal display

adapter or any other portable computer device which is then used to answer the

questionnaire to record user preferences. (Page 23, line 8 through Page 24, line 4)

Claim 19:   DeLorme discloses the method of claim 1, wherein user

preferences are identified based at least in part upon user preference information that is

associated with a credit card. (Page 32, lines 1-31)

Claim 20:   DeLorme discloses the method of claim 19, wherein user

preferences are obtained from a database using identification information from the

credit card. (Page 32, lines 1-31)

Claim 21:   DeLorme discloses the method of claim 20, wherein the database

contains an answer list previously completed by the user. (Page 56, line 1 through Page

58, line 13)

Claim 23:   DeLorme discloses the method of claim 1, wherein retrieving

service provider information includes retrieving service provider information available on

the Internet or in general databases to enhance the content of the customized

information document. (Page 21, line 23 through Page 22, line 20)

Claim 24:   DeLorme discloses the method of claim 1, wherein recording user

preferences includes retrieving previously recorded user preferences to generate

customized content when the user visits other service hosts. (Page 50, line 27 through

Page 51, line 2)

Claim 25:   DeLorme discloses the method of claim 1, wherein identifying a

portion of the service provider information includes statistically analyzing the most

popular service providers that are selected by users with similar profiles. (Page 104,

lines 6-23)

Claim 26:   DeLorme discloses the method of claim 1, wherein a service

provider receives reports on the number of times the corresponding service provider

information has been included in a plurality of custom information documents. (Page

104, lines 6-23)

Claim 27:   DeLorme discloses the method of claim 1, wherein a service

provider specifies in the custom information document which service provider

information is retrievable for inclusion in the custom information document. (Page 105,

line 7 through Page 107, line 14)

Claim 29:   DeLorme discloses a method providing formatted service provider

information, comprising:

     a.   Generating a questionnaire with a plurality of questions, with each

question having one or more potential answers. (Page 45, line 21

through Page 46, line 23)

     b.   Associating at least one reference to service provider information

with each potential answer. (Page 45, line 21 through Page 46, line

23)

     c.   Receiving answers to the questionnaire. (Page 45, line 21 through

Page 46, line 23)

     d.   Generating an answer list comprising the associated references to

the received answers. (Page 45, line 21 through Page 46, line 23)

     e.   Retrieving service provider information for at least one of the

references in the answer list. (Page 45, line 21 through Page 46,

line 23)

     f.   Formatting the service provider information in a layout suitable for

printing or viewing. (Page 45, line 21 through Page 46, line 23)

g.   Outputting the formatted service provider information to an output

device. (Page 45, line 21 through Page 46, line 23)

Claim 30:   DeLorme discloses the method of claim 29, wherein information

about the geographical location of service hosts and service providers is retrieved and

is used to determine location relevance. (Page 45, line 21 through Page 46, line 23)

Claim 31:   DeLorme discloses the method of claim 29, wherein the service

provider information includes the geographical location of a service provider and

therefor the geographic location is used to generate a mark on a map indicating the

position of the service on the map. (Page 26, line 26 through Page 27, line 32)

Claim 32:   DeLorme discloses the method of claim 29, wherein the service

provider specifies the information to be retrieved from one or more sets of information.

(Page 21, line 23 through Page 22, line 20)

Claim 33:   DeLorme discloses the method of claim 32, wherein the service

provider specifies the information set to be retrieved based on a time constraint. (Page

21, line 23 through Page 22, line 20 and Page 34, lines 5-28)

Claim 34:   DeLorme discloses the method of claim 33, wherein the service

provider specifies the information set to be retrieved based on the number of

information guides that have been created during a selected time interval and that

incorporate the service provider information. (Page 21, line 23 through Page 22, line 20

and Page 34, lines 5-28)

Claim 35:   DeLorme discloses the method of claim 33, wherein the service

provider can interactively edit or select the service provider information that is to be

retrieved. (Page 21, line 23 through Page 22, line 20 and Page 34, lines 5-28)

Claim 36:   DeLorme discloses the method of claim 29, wherein the user

answers the questionnaire with a pen or pencil, and the questionnaire is scanned and

processed by a program to determine answers. (Page 24, lines 5-18 and Page 45, line

21 through Page 46, line 23)

Claim 37:   DeLorme discloses the method of claim 29, wherein handwritten

information on the questionnaire is stored by the program. . (Page 24, lines 5-18)

Claim 38:   DeLorme discloses the method of claim 29, wherein different

questionnaires are printed for different user profiles. (Page 56, lines 1-14)

Claim 39:   DeLorme discloses the method of claim 29, wherein user answers

the questionnaire using a web browser to record user answers. (Page 23, line 8 through

Page 24, line 4)

Claim 40:   DeLorme discloses the method of claim 29, wherein the user

answers the questionnaire using the remote control of the television to record user

preferences. (Page 23, line 8 through Page 24, line 4)

Claim 41:   DeLorme discloses the method of claim 29, wherein the user

answers the questionnaire with voice messages and the questionnaire is answered

through the telephone. (Page 23, line 8 through Page 24, line 4 and Page 38, line 12

through Page 39, line 4)

Claim 42:   DeLorme discloses the method of claim 29, wherein the

questionnaire is formatted by a program to produce a file that is downloaded to a

personal display adapter or any other portable computer device and the device is then

used to answer the questionnaire to record user preferences. (Page 23, line 8 through

Page 24, line 4 and Page 38, line 12 through Page 39, line 4)

Claim 43:   DeLorme discloses the method of claim 29, further comprising

associating answer list information with a credit card. (Page 32, lines 1-31)

Claim 44:   DeLorme discloses the method of claim 43, wherein the answer list

is stored in a database and obtained at least in part from the database using the answer

list information from the credit card. (Page 32, lines 1-31)

Claim 45:   DeLorme discloses the method of claim 44, wherein the database

contains an answer list previously completed by the user. (Page 56, line 1 through Page

58, line 13)

Claim 47:   DeLorme discloses the method of claim 29, further comprising

retrieving information available on the Internet or in general databases for inclusion in

the formatted service provider information. (Page 21, line 23 through Page 22, line 20)

Claim 48:   DeLorme discloses the method of claim 29, further comprising

retrieving previously recorded answer lists to generate the answer list. (Page 56, line 1

through Page 58, line 13)

Claim 50:   DeLorme discloses a system to produce customized information

documents, comprising:

      a.   Means for storing service provider information that describes one or

           more aspects of a service provider. (Page 45, line 21 through Page

           46, line 23)

      b.   Means for inputting a set of user preferences. (Page 45, line 21

           through Page 46, line 23)

      c.   Means for associating selecting information content, wherein the

           information content that is selected is based at least in part upon

           the input user preferences. (Page 45, line 21 through Page 46, line

           23)

      d.   Means for storing layout information. (Page 26, 5-25)

      e.   Means for formatting the selected information content with the

           layout information in the form of a guide suitable for printing or

           viewing in a plurality of media. (Page 45, line 21 through Page 46,

           line 23)

      f.   Means for outputting the guide to an output device. (Page 45, line

           21 through Page 46, line 23)

Claim 51:   DeLorme discloses the method of claim 50, wherein the user

answers the questionnaire by scanning bar codes printed on products. (Page 23, line 8

through Page 24, line 4).

Claim 52:   DeLorme discloses the method of claim 50, wherein the user

answers the questionnaire by scanning bar codes printed in cards designed for such a

propose. (Page 23, line 8 through Page 24, line 4)

Claim 53:   DeLorme discloses the method of claim 50, wherein the guide is a

travel guide. (Page 45, line 21 through Page 46, line 23)

Claim 54:   DeLorme discloses The method of claim 50, wherein the

information content relates to travel attractions. (Page 45, line 21 through Page 46, line

23)

Claim 55:   DeLorme discloses a program storage device storing instructions

that when executed perform the method comprising:

    a.   Recording a plurality of user preferences. (Page 45, line 21 through

        Page 46, line 23)

    b.   Retrieving service provider information that is associated with a

        service host, a location, or a subject. (Page 45, line 21 through

        Page 46, line 23)

    c.   Identifying a portion of the information that relates to the user

        preferences. (Page 45, line 21 through Page 46, line 23)

    d.   Creating a custom information document using the identified portion

        of the service provider information; and outputting the custom

        information document. (Page 45, line 21 through Page 46, line 23)

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 22 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable

over DeLorme et al (WO 98/35311).

Claim 22:   DeLorme discloses the method of claim 19, wherein user

preferences are stored on various devices such as a smart card (Page 26, 5-25). While

DeLorme is silent with regard to the use of a credit card for storage, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to

allow for the storage medium to be a credit card. One would have been motivated to

store the user preferences on a credit card in order to provide users with the ability to

transfer data from one point to another without incurring the overhead cost of

purchasing a smart card or other portable computing device.

Claim 46:   DeLorme discloses the method of claim 29, wherein the user

answer list is stored on various devices such as a smart card (Page 26, 5-25). While

DeLorme is silent with regard to the use of a credit card for storage, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to

allow for the storage medium to be a credit card. One would have been motivated to

store the user preferences on a credit card in order to provide users with the ability to

transfer data from one point to another without incurring the overhead cost of

purchasing a smart card or other portable computing device.

5.   Claims 28 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable

over DeLorme et al (WO 98/35311) in view of Jacobi et al. (U.S. Patent Number:

6,317,722).

Claim 28:   DeLorme discloses the method of claim 1, further comprising

retrieving reviews of service providers and service hosts (Page 104, lines 6-24), but is

silent with regard to whether the ratings service includes direct input from users who

have received an information guide. However, Jacobi discloses a user recommendation

service for use with service providers (Col 5, line 57 through Col 6, line 51). It would

have been obvious to one having ordinary skill in the art at the time of the invention to

include user reviews. One would have been motivated to include user reviews in order

to provide users with additional information with regard to real life experiences while

using a provider's services.

Claim 49:   DeLorme discloses the method of claim 29, further comprising

retrieving reviews of service providers and service hosts (Page 104, lines 6-24), but is

silent with regard to whether the ratings service includes direct input from other users

who have received an information guide. However, Jacobi discloses a user

recommendation service for use with service providers (Col 5, line 57 through Col 6, line

51). It would have been obvious to one having ordinary skill in the art at the time of the

invention to include user reviews. One would have been motivated to include user

reviews in order to provide users with additional information with regard to real life experiences while using a provider's services.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

> DeLorme et al. (U.S. Patent Number 5,559,707) discloses a travel
>
> planning and routing system that includes service provider locations.
>
> Strubbe (U.S. Patent Number 5,223,924) discloses gathering user
>
> preferences with the use of an interactive television network.

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

jvb
November 23, 2005

JAMES W. MYHRE
PRIMARY EXAMINER